

8. (Pending) The semiconductor device of Claim 7, wherein the at least two gated diodes are arranged as a MOS transistor having a further zone of the second conductivity type.

9. (Amended) The semiconductor device of Claim 7, wherein the cathode of the SCR is provided along the part of the periphery of the well of the second conductivity type that is free from the at least two gated diodes.

#### REMARKS

Claims 1-9 are pending. By this amendment, claims 7 and 9 have been amended. Reconsideration and allowance are respectfully requested in view of the above amendments and the following remarks. No new matter is believed added.

Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonable convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, the Examiner alleges that there "is no support for at least two gated diodes, as recited in claims 1 and 7-8." Applicants' respectfully disagree and direct the Examiner's attention to FIG. 6 of the application which clearly discloses the claimed "at least two gated diodes" (see reference numerals 17 and 18). Accordingly, Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. 112, first paragraph.

The dependency of claim 7 has been corrected to overcome the rejection under 35 U.S.C.

112, second paragraph. In addition, claim 9 has been amended to correct a typographical error.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ker et al. (US 5,572,394), hereafter "Ker." This rejection is defective because Ker fails to teach or suggest each and every feature of the claims as required by 35 U.S.C. 103. Further, the Examiner has failed to present a *prima facie* case of obviousness in support of the rejection under 35 U.S.C. 103.

Regarding independent claim 1, Ker fails to teach or suggest, *inter alia*, a protection means "being a compound element of an SCR and at least two gated diodes." Rather, Ker only discloses a single diode per protection means (see, e.g., FIG. 9). Indeed, the Office admits this fact in the second paragraph on page 4 of the above-referenced Office Action. The Office attempts to overcome this deficiency of Ker by alleging that it "would have been obvious to a person of ordinary skill in the art at the time the invention was made to use two gated diodes in Ker et al.'s device in order to use the device in an application which requires plurality of protection circuits." Applicants respectively disagree with the Examiner's conclusion.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met (see MPEP 2143). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Regarding the first of the three basic criteria, the Office has failed to present any evidence to support the allegation that it "would have been obvious to a person of ordinary skill in the art at the time the invention was made to use two gated diodes in Ker et al.'s

device in order to use the device in an application which requires plurality of protection circuits.”

The Office, in its attempt to modify the reference to Ker, has not proven that the use of “two gated diodes” in the claimed protection means is within the knowledge generally available to one of ordinary skill in the art. Accordingly, since Ker fails to teach or suggest each and every feature of independent claim 1 as required by 35 U.S.C. 103(a), and there is no motivation to modify Ker to arrive at Applicants’ invention, Applicants respectfully submit that claim 1 and its dependent claims are allowable.

Applicants respectfully submit that, unless expressly stated otherwise: (1) no amendment made was related to the statutory requirements of patentability; and (2) no amendment was made for the purpose of narrowing the scope of any claims. Applicants further respectfully submit that the application is in condition for allowance. Should the Examiner believe that anything further is necessary, the Examiner is requested to contact Applicants’ undersigned attorney at the telephone number listed below.

Respectfully submitted,



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**SEPARATE MARKUP SHEET**

7. (Amended) The semiconductor device of Claim [7] 6, wherein the at least two gated diodes are provided on [the right-hand] one end of the longitudinal zone and comprises the insulated gate and the highly doped second conductivity type surface zone which partly overlaps the well of the second conductivity type.

9. (Amended) The semiconductor device of Claim 7, wherein the cathode of the SCR is provided along the part of the periphery of the well of the second conductivity type that is free from the at least two [gates] gated diodes.

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